

REMARKS/ARGUMENTS

Claims 1, 8, 10-11, 13 and 14 have been amended. Support for the amendment is found at specification page 1, lines 6-14. Support for new Claims 18-19 is found at specification page 7, lines 9-11 and page 13, lines 7-15. No new matter has been added.

The rejection of Claims 1-4, 6-10, 12, 15-17 under 35 U.S.C. 103(a) as being unpatentable over Warnes (2003/0022012) in view of Schaeffer (6,123,997) is traversed.

Warnes discloses an aluminide bondcoat. However, Warnes does not disclose “treating the surface of the substrate with a ceramic powder mainly having a crystal structure which is the same as that of alumina in the alpha crystal structure to form fine scratches on the surface of the substrate” as in amended Claim 1. Furthermore, the aluminide bondcoat of Warnes is thermally grown (See, Warnes, paragraph [0034]). On the contrary, the method as in amended Claim 1 deposits an alumina layer of alpha crystal structure on a substrate.

The secondary reference to Schaeffer does not cure the deficiencies of Warnes because Schaeffer does not disclose forming fine scratches on the surface of the substrate or and depositing an alumina layer of alpha crystal structure on a substrate amended Claim 1.

Therefore, Warnes in combination with Schaeffer cannot make obvious present Claim 1 and the claims dependent therefrom.

Furthermore, Warnes emphasizes that “[t]he optimum fully transformed alpha alumina layer cannot be formed during the EB-PVD pre-heat cycle, or any other thermal process at reduced oxygen pressure and temperature below 1950 degrees F” (See, page 4, paragraph [0042]). Schaeffer also discloses that a temperature of at least 2000°F is required to produce an alumina scale of at least 90% α -alumina coating (see, Col.6, lines 1-9).

On the contrary, Applicants teach, in one embodiment, depositing the alumina film mainly in alpha crystal structure at a temperature of 650 to 800°C (1202-1472°F) on the substrate (See, specification page 12, and Claim 13 and new Claim 18).

Additionally, both Warnes and Schaeffer carry out the coating at a high pressure. In detail, the coating of Warnes is carried out at a pressure of 150 torr ($\approx 2 \times 10^4$ Pa) (See, Warnes, Page 3, paragraph [0026]) and the oxidation in Schaeffer is carried out at a pressure of from 7 to 103 MPa (See, Schaeffer, Col.5, lines 34-48).

On the contrary, the alumina film of the present application may be formed at a low pressure of 0.75 Pa (See, specification page 13, lines 7-15, and new Claim 19).

Applicants respectfully note that MPEP 2141.02 VI describes, in part, that “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” Applicants submit that the Office has failed to consider Warnes as a whole, and that if Warnes is considered as a whole, as described above, Warnes even in combination with Schaeffer, does not enable one of ordinary skill in the art to carry out a method as in present Claim 1.

Withdrawal of the rejection is respectfully requested.

The rejection of Claim 4 under 35 U.S.C. 103(a) as being unpatentable over Warnes in view of Schaeffer and Hecht (3,928026) is traversed.

Hecht does not cure the deficiencies of Warnes and Schaeffer because 1) Hecht does not disclose or suggest treating the surface of the substrate with a ceramic powder mainly having a crystal structure which is the same as that of alumina in the alpha crystal structure to form fine scratches on the surface of the substrate as in amended Claim 1; and 2) Hecht does not disclose or suggest depositing the alumina film mainly in alpha crystal structure on the substrate as in amended Claim 1.

Withdrawal of the rejection is respectfully requested.

The rejection of Claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Warnes in view Schaeffer and Taira (JP2001-342556, English computer translation) is traversed.

Taira does not cure the deficiencies of Warnes and Schaeffer.

Taira discloses forming a chrome oxide crystalline thin film in a substrate and forming an aluminum crystalline thin film on the chrome oxide crystalline thin film (See, English translation, paragraph [0003]). In detail, Taira teaches forming a chrome oxide crystalline film of 200 nm thickness on a substrate and then forming an alumina film of 300 nm thickness on the chrome oxide crystalline film of 200 nm thickness (See, English translation, paragraphs [0012]-[0013]).

However, Taira does not disclose or suggest treating the surface of the substrate with a ceramic powder mainly having a crystal structure which is the same as that of alumina in the alpha crystal structure to form fine scratches on the surface of the substrate as in amended Claim 1; and 2) Taira does not disclose or suggest depositing the alumina film mainly in alpha crystal structure on the substrate as in amended Claim 1.

Withdrawal of the rejection is respectfully requested.

The rejection of Claims 1, 4, 5 and 11 under 35 U.S.C. 103(a) as being unpatentable over Ivori (6,254,984) in view of Warnes, Schaeffer, and Ikeda (Thin Solid Films) is traversed.

Ivori discloses a multi-layer-coated member obtained by coating a hard alloy substrate with layers of carbides, nitrides, or carbonitrides (See, Ivori, Claim 1). However, Ivory does not disclose or suggest treating the surface of the substrate with a ceramic powder mainly having a crystal structure which is the same as that of alumina in the alpha crystal structure to form fine scratches on the surface of the substrate as in amended Claim 1 and depositing the alumina film mainly in alpha crystal structure on the substrate as in amended Claim 1.

The secondary references do not cure the deficiencies of Ivori because of the same reasons discussed above.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.
Norman F. Oblon



Soonwuk Cheong, Ph.D
Registration No. 62,793

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/09)